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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/542,418	04/04/2000	Thomas F Dibiaso		5678

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EXAMINER

NGUYEN, TUAN N

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/542,418	Applicant(s)	D'Biase et al
Examiner	Tuan Nguyen	Art Unit	3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 11/18/02

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-3, 14-19, 33-40 and 48-70 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3, 14-19, 33-40 and 48-70 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_  Other: \_\_\_\_\_

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**DETAILED ACTION**

1. After further reconsideration, a new ground of rejection will be applied in this Office action.
2. Applicant's election without traverse of Group I in Paper No. 7 filed on Sept. 20, 2001 is acknowledged.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 14-19, 33-40 and 48-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens et al.'099 in view of Kruk, Jr. et al..

Stevens et al.'099 have been discussed in paragraph 3 of the Office action mailed on December 05, 2001. However, Stevens et al.'099 do not disclose a step of cutting or severing three edges of an envelope, and do not disclose an envelope having at least three documents.

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However, Kruk, Jr. et al. disclose an apparatus and a method for processing mail envelopes having a plurality contents or documents. Since Kruk, Jr. et al. do not specify how many documents inside an envelope, it is reasonable to assume the envelope can have three documents inside. The apparatus and method comprise an envelope opener (Fig. 6) to sever and open three edges (column 26, lines 17-20) of each of the envelopes; an extractor (column 7, lines 14-16) to extract the contents or documents from the opened envelope. Kruk, Jr. et al. further has a feeder (unshown) for feeding the mail envelopes to the envelopes opener; a thickness detector (column 25, lines 7-19) for detecting the thickness of each of the envelopes; a system controller 46 to control the feeder to feed a trailing piece of mail envelope in response to the detected thickness of a leading piece of mail envelope to maintain a proper spacing between the leading and trailing piece of mail envelopes; an orienting station (column 16, lines 40-43) to detect and correction a proper orientation of the extracted contents or documents; and a sorter (unscannable contents set aside in Fig. 19) for sorting the extracted contents or documents into one of a plurality bins (unshown).

It would have been obvious to one of ordinary skill in the art to modify the envelope opener of Steven et al. '099 to be able to cut or sever three edges of an envelope as taught by Kruk, Jr. et al. to expose the contents inside so an extractor has an easier time to extract the contents from the envelope (Kruk, Jr. et al., column 26, lines 17-29); and it would be obvious to one skill in the art to modify the envelope of Stevens et al. '099 to have at least three documents inside as taught by Kruk, Jr. et al.. Such modification constitutes an optimum or number of items

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ranges well known in the art. In re Aller, 105 USPQ 233. Re claim 1, it would have been obvious to one skill in the art to modify the depth of the third edge cut of Stevens et al. '099-Kruk, Jr. et al. to be greater than the depth of cut of either the first or second edge. Such modification depends from the size of the contents or documents inside the mail envelope, i.e. if the size of the contents or documents is smaller than the size of the envelope, the depth of the third edge cut can be greater than the depth of cut of the first and second edge.

5. Applicant's arguments with respect to claims 1-3, 14-19, 33-40 and 48-70 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication should be directed to Examiner Tuan Nguyen at telephone number (703) 308-3664.

  
1/27/03

tnn,

January 27, 2003.